



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,114	08/24/2001	Barry N. Gellman	BSC-128	3367

21323 7590 07/10/2003

TESTA, HURWITZ & THIBEAULT, LLP  
HIGH STREET TOWER  
125 HIGH STREET  
BOSTON, MA 02110

EXAMINER

PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 07/10/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/939,114

Applicant(s)

GELLMAN ET AL.

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on May 14<sup>th</sup>, 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-19 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent No. 5,709,693 to Taylor. Regarding Claim 1, Taylor discloses a suturing instrument including all of the claimed components. Taylor has an elongate body member (30), a forward-deploying needle carrier (24) [Column 2, lines 29-34 and 54-60], and a needle catch (22 – as labeled in Fig. 1A) [to receive and retain the needle (12)]. The needle of Taylor's invention travels in a circle [Column 1, lines 46-50]. Taylor's invention has a forward directed exit port. Both the needle catch and the exit port are disposed on a front face of the distal end of the elongate body member (30).

It is suggested that the Applicant amend the claims to include functional language, which says that the needle carrier comes out of the exit port. For example, the Applicant could insert the phrase –for deployment of the needle carrier therethrough—in between the words “forward-directed exit port” and “wherein the needle catch”.

2. Regarding Claims 2 and 3, Taylor discloses a suturing instrument, which also has a deployment controller (16). The deployment controller (16) extends along the longitudinal axis of the elongate body member (30) and its distal end is coupled to the

needle carrier (24) [Fig. 1]. There is an actuator (18) coupled to the proximal end of the deployment controller (16) [see Fig. 1].

1. Regarding Claim 4, Taylor discloses a suturing instrument which has a deployment controller (16) which is configured to guide the needle carrier (24) along a proximal curved path segment leading initially away from the elongate body member (30) and then towards the elongate body member (30) [see Fig. 1; Column 2, lines 44-50].
2. Regarding Claims 5 and 6, Taylor discloses a suturing instrument with a second needle carrier (22) [Column 2, lines 54-59]. His instrument also includes a suture (14) with an attached needle (12) [Column 2, lines 27-32].
3. Regarding Claims 7 and 8, Taylor discloses a suturing instrument in which the needle (12) inserts into the needle carrier (24) [see Fig. 1]. The catch (22) is positioned on the elongate body member (30) such that a distal path segment of the needle carrier's path is intercepted by the catch (22) [Column 1, lines 46-50].
4. Applicant's arguments filed May 14<sup>th</sup>, 2003 have been fully considered but they are not persuasive. Rejection of Claims 20-23 with U.S. Patent No. 5,899,909 to Claren et al. is maintained. Figure 5 clearly shows the needle extending through the abdominal wall (32) and the pelvic floor *simultaneously*. Claren discloses retrieving the needle (21A) using forceps, drawing the needle (21A) from the position shown in Figure 6 to the position shown in Figure 7. Therefore, Claren *does, in fact*, disclose

Art Unit: 3731

retrieving the suture through the tissue of the pelvic floor as recited in Claim 20.

Further, Claren's suture (26) is attached to the needle (21A), as shown in Figure 5.

***Allowable Subject Matter***

5. Claims 9 and 10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 11-19 are allowed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,557,265 to Andersson

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.


Art Unit: 3731

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

*BCP*

BCP

July 7, 2003

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700